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8-701

PATENT
Customer No. 22,852
Attorney Docket No. 5788.0124.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Paola CARACINO et al.)
)
Serial No.: 09/498,062) Group Art Unit: 2841
)
Filed: February 4, 2000) Examiner: Vu, Q.
)
For: HIGH TEMPERATURE)
SUPERCONDUCTING CABLE)
AND PROCESS FOR)
MANUFACTURING THE SAME)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicants submit this Response to Restriction Requirement, accompanied by a Second Supplemental Preliminary Amendment and a Petition for Extension of Time, in reply to the Office Action mailed June 14, 2001.

In the Office Action, the Examiner required restriction under 35 U.S.C. § 121 between Group I, claims 1-17, characterized by the Examiner as drawn to a high temperature super-conducting cable; and Group II, claims 18-20, characterized by the Examiner as drawn to a process for manufacturing [a] high temperature super-conducting cable.

Applicants submit that the specification as originally-filed on February 4, 2000, included claims 1-24. In a Preliminary Amendment also filed on February 4, 2000, Applicants: canceled, without prejudice or disclaimer, claims 2 and 19; amended claims 1, 3-10, 18, and 20-24; and added new claims 25 and 26. A Supplemental Preliminary Amendment filed June 16, 2000, did

not change the then pending claims. Thus, prior to entry of the Second Supplemental Preliminary Amendment, the application included pending claims 1, 3-18, and 20-26.

In the Second Supplemental Preliminary Amendment, Applicants cancel, without prejudice or disclaimer, claims 1, 3-10, and 20-26, and add new claims 27-50, which include the same subject matter as the original claims, to improve clarity. The originally filed specification, claims, abstract, and drawings fully support the added claims. No new matter was introduced.

Thus, after entry of the Second Supplemental Preliminary Amendment, the application includes pending claims 27-50. New claims 27-43 recite, *inter alia*, a "high temperature superconducting cable." New claims 44-50 recite, *inter alia*, a "process for manufacturing a high temperature superconducting cable." Therefore, Applicants understand the restriction requirement to require restriction under 35 U.S.C. § 121 between Group I, claims 27-43, characterized by the Examiner as drawn to a high temperature super-conducting cable; and Group II, claims 44-50, characterized by the Examiner as drawn to a process for manufacturing a high temperature super-conducting cable. Given this understanding, Applicants provisionally elect, with traverse, to prosecute Group I, new claims 27-43.

Regarding traverse of the restriction requirement, Applicants respectfully submit that the search and examination of this entire application can be made without serious burden. As such, MPEP § 803, ¶ 2, requires that the entire application be examined on the merits. Therefore, Applicants respectfully request such examination, including examination of *all* pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 31, 2001

By: 

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